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SERIAL NUMBER	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/419,719 04/10/95 AUGUSTINE

S 1342-119

EXAMINER

GRAHAM, M

F3M1/0914

ART UNIT

PAPER NUMBER

TERRANCE A MEADOR
BAKER MAXHAM JESTER & MEADOR
SYMPHONY TOWERS
750 B STREET SUITE 2770
SAN DIEGO CA 92101

3304

DATE MAILED:

09/14/95

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 9/10/95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474..
6. PTO 152

Part II SUMMARY OF ACTION

1. Claims 1-3, 8-10 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-3, 8-10 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit: 3304

Claims 1-3 and 8-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Base claims 1 and 8 both recite that the blanket is "sized to extend" across a certain portion of a patients body.

Obviously this is a dimension which would vary from patient to patient thus leaving the limits on the claims unclear.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 8 and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Kliesrath in view of Augustine¹¹⁸ for the reasons set forth in the 11/5/91 rejection of the parent application.

Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over the art as applied to claim 8 above, and

further in view of Sandhaus for the reasons set forth in the 11/5/91 rejection of the parent application.

Claims 1 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,324,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because sizing the '320 blanket to fit various areas of the body would have been obvious to one of ordinary skill in the art.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,324,320 in view of Kliesrath for the reasons set forth in the 11/5/91 rejection of the parent application.

Claims 3 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,324,320 in view of Sandhaus for the reasons set forth in the 11/5/91 rejection of the parent application.

Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,324,320 in view of Greene for the reasons set forth in the 11/5/91 rejection of the parent application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

This is a continuation of applicant's earlier application S.N. 07/638,748. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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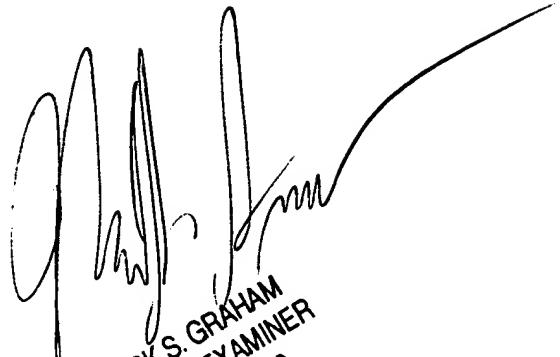
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Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG

September 8, 1995



MARK S. GRAHAM
PRIMARY EXAMINER
GROUP 3300

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
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DATE MAILED: *3***NOTICE OF INFORMAL APPLICATION**

(Attachment to Office Action)

This application does not conform with the rules governing applications for the reason(s) checked below. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the application number and filing date is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

1. does not identify the city and state or foreign country of residence of each inventor.
2. does not identify the citizenship of each inventor.
3. does not state whether the inventor is a sole or joint inventor.
4. does not state that the person making the oath or declaration:
 - a. has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. believes the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
 - c. acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
5. does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
6. does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
7. does not include the date of execution.
8. does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).
9. contains non-initialed alterations (See 37 CFR 1.52(c)).
10. Other:

B. Applicant is required to provide:

1. A statement signed by applicant giving his or her complete name. A full name must include at least one given name without abbreviation as required by (37 CFR 1.41(a)).
2. Proof of authority of the legal representative under 37 CFR 1.44.
3. An abstract in compliance with 37 CFR 1.72(b).
4. A statement signed by applicant giving his or her complete post office address (37 CFR 1.33(a)).
5. A copy of the specification written, typed, or printed in permanent ink, or its equivalent in quality as required by 37 CFR 1.52(a).

6. Other: *A LABEL FOR DRAWING FIGURES 2, 5, 7, 9 & 11.*

PART 1-OFFICE COPY